

## REMARKS

### A. Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the opinion that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the above amendments to the claims, the Terminal Disclaimer and the following remarks.

### B. Claims Status

Claims 1, 5-11, 13, 18 and 27 are pending in this Application.

Claims 21-26 have been canceled herein.

Claim 1 has been amended herein to recite that the spiraling flow of gas is from a gas stream introduced into the intermediate chamber. Claim 1 has also been amended to recite that the collected non-transferred toner is transported from the toner intermediate chamber by use of the gas stream to the development device so as to reuse the collected non-transferred toner. Support for these amendments can be found, for example, on page 11, lines 10-15 and page 12, lines 20-22.

Respectfully, no new matter has been added by way of these amendments.

C. Rejections Under 35 USC 112

1. Second Paragraph

The Examiner had rejected claims 1, 5-11, 13, 18 and 21-27 under 35 USC 112, second paragraph, as being indefinite. The Examiner made two points.

First, the Examiner noted a typographical error in claims 1 and 21. Claim 1 has been amended herein to correctly recite "fixing the formed toner image on the transfer material". Claim 21 has been cancelled herein.

Second, the Examiner has taken the position that the claims are not clear as to what "collected non-transferred toner" is used. Claim 1 has been amended herein to identify that the reused toner is from the intermediate chamber. Claim 21 has been cancelled herein.

In view of the amendments made to claim 1, Applicants respectfully submit that claim 1 is now definite as well as its dependent claims.

2. First Paragraph

The Examiner had rejected claims 21-26 under 35 USC 112, first paragraph, for failing to comply with the written description requirement. Claims 21-26 have been cancelled herein. Thus, this rejection is now moot.

#### D. Prior Art Rejection

The Examiner put forward the following three Prior Art rejections:

(1) claims 21 and 23-26 are unpatentable over JP 10-319813 (JP '813) in combination with Ohmura (US 2003/0148204), Matsushima '647 (US 2003/0113647) and Hayashi (US 6,395,442);

(2) claims 1, 8-11, 13 and 18 are rejected as unpatentable over Taffler (US 5,521,690) in combination with Ohmura; and

(3) claims 5, 18 and 27 are rejected as unpatentable over Taffler in combination with Ohmura and further in combination with Matsushima '647 and Hayashi.

Turning to rejection (1), in light of cancelling claims 21-26, this rejection is now moot.

Turning to rejections (2) and (3), in a previous Office Action, Applicants had submitted a Certified Copy of the Priority Document so as to remove Ohmura and Matsushima as Prior Art. In response to this Submission, the Examiner takes the position that the Priority Document does not support claim 1 because the Priority Document requires "a toner containing collected non-transferred toner is used after passing through a toner intermediate chamber with gas". As noted above, claim 1 has been amended herein to recite: (i) that the spiraling flow of gas is from a gas stream introduced into the intermediate chamber and (ii) that the collected non-transferred toner is

transported from the toner intermediate chamber by use of the gas stream to the development device so as to reuse the collected non-transferred toner. Support can be found on page 13, lines 11-16 and page 14, lines 16-18 of the Priority Document. Thus, it is submitted that these aspects of claim 1 are fully supported now by the Priority Document.

It is respectfully submitted now that the Priority Document clearly supports independent claim 1 as well as the dependent claims thereon and, thus, Ohmura and Matsushima are not Prior Art to the claims as presented herein.

Moreover, Applicants submit that Taffler and Hayashi do not cure the deficiencies of Ohmura and Matsushima. Thus, in view of the foregoing, it is respectfully submitted that the claims, as presented herein, are patentable over the references taken alone or in combination.

**E. Double Patenting Rejection**

The Examiner has made the following three double patenting rejections:

(1) claims 21-26 are rejected on the grounds of obviousness-type double patenting based on claims 1-16 of Ohmura '208 (US 7,378,208) in view of JP '813;

(2) claims 1, 5, 6, 8-11, 13, 18 and 27 are rejected on the grounds of obviousness-type double patenting based on claims 1-16 of Ohmura '208 in view of Taffler; and

(3) claim 7 is rejected on the grounds of obviousness-type double patenting based on claims 1-16 of Ohmura '208 in view of Taffler and Misawa (US 5,387,665).

With respect to double patenting rejections (1)-(3), a Terminal Disclaimer has been submitted for Ohmura '208.

**F. Request for One-Month Extension of Time**

Applicants hereby petition for a one month extension of time within which to respond to the outstanding Office Action and, in that vein, the fee associated with the one month extension is paid herewith.

Should any additional fees or extensions of time be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to Debit Account #02-2275.

F. Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By: Donald C. Lucas  
Donald C. Lucas, Reg. #31,275  
(Attorney for Applicants)  
475 Park Avenue South  
New York, New York 10016  
Tel. # (212) 661-8000

DCL/CMJ/mr